

### **REMARKS**

As a result of this amendment, claims 1-9, 14, 15, 17, and 19-49 are pending. Of these, claims 1-9, 14-15 and 17 have been rejected under §102.

Applicant reserves all applicable rights not exercised in connection with this response, including, for example, the right swear behind one or more of the cited references and the right to rebut any tacit or explicit characterization of the references.

### **Information Disclosure Statement**

Applicant respectfully requests that a signed copy of the 1449 Form, acknowledging consideration of all references submitted with the Information Disclosure Statement filed on February 10, 2000, be returned with the next official communication.

### **Affirmation of Election**

Applicant hereby affirms the provisional election made by its patent counsel Eduardo Drake, on October 11, 2001, to prosecute the invention of Group I, claims 1-9, 14-15 and 17 drawn to automatically inserting hyperlinks.

The claims of the non-elected inventions of Group II and Group III, specifically claims 10-13, 16 and 18, are hereby canceled. However, applicant reserves the right to file continuations or divisions having claims directed to the non-elected inventions.

### **Response to §102 Rejections**

The Action rejects claims 1-9, 14-15 and 17, under 35 USC §102(e), as anticipated by Horowitz (U.S. Patent 6,122,647). However, applicant respectfully submits that Horowitz fails to meet each and every requirement of these claims.

Regarding **claims 1-3**, Horowitz fails, for example, to teach acts, steps, or means for “searching one or more documents for content matching one or more predefined forms” and “marking one or more portions of one or more of the documents based on results of searching the one or more documents.”

In contrast, Horowitz reports “identifying a set of terms and topics that are relevant to the selected portion or about the selected portion, ... generating tags in the document which associate

the terms and topics [in knowledge base 130,] determining a set of target documents associated with the generated tags in the document,... and constructing a set of hypertext links to the target documents [in the knowledge base.]” (Column 6, lines 49-59.) However, neither this passage, nor any other in Horowitz teaches “searching [the documents in which portions will be marked] for content matching predefined forms and marking the document based on the results of this searching.

In addressing this requirement, the Examiner cites column 7, lines 1-67 as teaching “searching one or more documents” and column 3, lines 1-8 as teaching “for content matching predefined forms,” apparently treating “links” as a predefined form.

However, as applicant reads these passages, neither meets the requirement of “searching [the documents in which portions will be marked] for content matching predefined forms and marking the document based on the results of this searching.” The column-7 passage reports a process of generating additional links for a user-selected portion of document while browsing or navigating web content.

Although searching possibly occurs in this process, the search is not for content in the document that matches predefined forms. Instead, the search is for target documents in the knowledge base that are related to the user-selected portion of the document. See, for example, column 7, lines 19-23, which states: “[f]rom the selected portion 304 of the source document 300, a number of new contextual links to target documents 310 [in knowledge base] relevant to the selected portion 304 are generated. Thus, the searching is based on relevancy to the selected portion, not on one or more predefined forms.

The passage at column 3, lines 1-8 states:

[This] allows a link in a source document to reference not only target documents that existed at the time the source document is initially authored, but also to new target documents or web content that is published after the source document is authored or published by the publisher. This allows the user to always have links from a document to relevant other documents that are on the Internet or a local intranet.

Nothing in this passage conveys a search of a source document for content of particular forms. Instead, the passage conveys that links originally published in a source document can be extended to target documents that were published after the publication of the source document.

Accordingly, applicant respectfully requests that the 102 rejection of claim 1 be withdrawn.

**Claims 4-9 and 17** have been amended to more readily distinguish from Horowitz. In particular, these claims require that each generated hyperlink include at least a portion of the content of one or more of the marked portions of the documents.

In contrast, Horowitz appears to include only a network address, such as a URL in its links. Specifically regarding generation of links, Horowitz states, at column 10, lines 12-21:

The presentation module 150 receives the source document 300 and the set of tags created by the tagging module 120. For each tag (802), the presentation module 150 looks up 804 the topic(s) in the knowledge base 130 specified in the tag. For each such topic the presentation module 150 retrieves 806 the documents associated with the topic, or more particularly, retrieves the URL (or other specification of network location) for the document. The presentation module 150 creates 808 a link between the term in the tag, and each of the referenced documents.

Thus, Horowitz reports its hyperlinks as including a retrieved URL, not a portion of the content marked in the document.

Accordingly applicant respectfully request that the rejection of claims 4-9 and 17 be withdrawn.

**Claims 14 and 15** also distinguish from Horowitz. Specifically, claims 14 and 15 require “defining a hyperlink to point to one of at least two or more destinations based on one or more of the provided user preferences.”

In contrast, Horowitz fails to choose among multiple destinations in defining its hyperlinks. Instead, if more than one destination is possible, Horowitz reports providing a menu of multiple hyperlinks for a user to choose among. See, for example, column 10, lines 28 - column 11, line 2. Thus, no hyperlink is defined based on user preferences.

Accordingly, applicant respectfully requests that the 102 rejection of claims 14 and 15 also be withdrawn.

Conclusion

In view of the amended claims and highlighted deficiencies of Horowitz, applicant respectfully requests reconsideration of the application. Further, applicant invites the Examiner to telephone its patent counsel Eduardo Drake (612-349-9593) to resolve any issues which may delay allowance.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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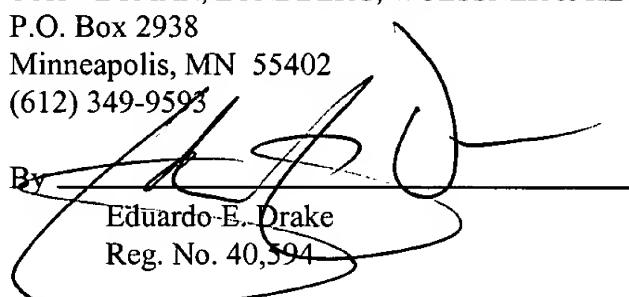
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Date

25 Feb 2002

By

  
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 28th day of February, 2001.

Name

~~Handwritten signature~~ Eduardo Drake

Signature

